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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,804	10/01/2003	Mitsuhiko Sato	CANO:91	3089

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EXAMINER

PHAM, HAI CHI

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,804

Applicant(s)

SATO ET AL.

Examiner

Hai C. Pham

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 5/1, 6/1, 7/1, 12/8, 13/8 and 14/8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5/1:

- The following limitation "one of said scanners" at line 3 lacks clear antecedent basis.

Claim 6/1:

- The following limitation "said plurality of scanners" at line 3 lacks clear antecedent basis.

Claim 7/1:

- The following limitation "one of said scanners" at line 3 lacks clear antecedent basis.

Claim 12/8:

- The following limitation "one of the scanners" at line 4 lacks clear antecedent basis.

Claim 13/8:

- The following limitation "the plurality of scanners" at line 4 lacks clear antecedent basis.

Claim 14/8:

- The following limitation "one of the scanners" at line 4 lacks clear antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2861

5. Claims 1-5 are 8-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Motoyama et al. (Pub. No. U.S. 2003/0194247).

Motoyama et al. discloses in Fig. 1 a color image recording apparatus comprising a plurality of image forming units (image forming portions a, d, c, d) that form images and overlap images the formed images onto a transfer material (intermediate transfer belt 16), a plurality of scanners (e.g., respective light sources and optical systems 14a-14d) that form images in said plurality of image forming units respectively, a first controller that has a first mode in which image formation is carried out by said plurality of image forming units (all color components including the black component being operative), and a second mode in which image formation is carried out by at least one of said image forming units (only black component being operative), said first controller starting a preparation for the image formation in the first mode while the image formation is being carried out in the second mode (in the embodiment, the color image recording apparatus is in the preparatory operation in the full-color mode when in the Automatic Color Selection or ACS mode and that a monochrome print is being determined by the ACS, it is then shifted to the monochrome mode where only the black component is operative to print a black and white image) (Figs. 8 and 10), and a second controller that carries out the image formation in the first mode after the image formation in the second mode is completed (it is noted that the full-color mode for forming a color image is not started until the monochrome printing operation is completed).

Motoyama et al. further teaches:

- wherein the image formation in the second mode (monochrome mode) is monochromatic image formation, and the image formation in the first mode (full-color mode) is image formation in a plurality of colors,
- wherein said first controller starts a preparation for applying high voltage to at least one of said image forming units that is not being used for the image formation in the second mode (see paragraph [0098]),
- wherein said first controller starts to drive at least one of said scanners that is not being used for the image formation in the second mode (e.g., charging up the photoconductor and developer).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-7 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama et al. in view of Ohki (U.S. 6,408,145).

Motoyama et al. discloses all the basic limitations of the claimed invention except for the second controller synchronizes said plurality of scanners after the image formation in the second mode is completed.

Ohki discloses an image forming apparatus including charger applied with voltage changed between monochrome mode and full-color mode, wherein when the

Art Unit: 2861

full-color mode operation is carried out in predetermined synchronous relation between the four color image forming stations such that the toner images formed in the image forming stations are successfully transferred onto the surface of the transfer material P in a superimposed manner (col. 10, lines 4-10).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to form the full-colored image by synchronizing the plural image forming units in Motoyama et al. device as taught by Ohki. The motivation for doing so would have been to prevent the misalignment of the plural toner images so as to provide a high quality image on the transfer material.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C. Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (571) 272-1934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2861

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HAI PHAM
PRIMARY EXAMINER

July 9, 2005